

Docket No.: E4800.0001/P001
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Michael Reed et al.

Petitions Examiner: David Bucci

Application No.: 08/113,955 ('955)

Confirmation No. 3543

Filed: August 31, 1993

For: MULTI-MEDIA SEARCH SYSTEM

DECLARATION OF JON D. GROSSMAN

Commissioner for Patents
Office of Petitions
P.O. Box 1450
Alexandria, VA 22313-1450

I, Jon D. Grossman, declare as follows:

1. I submit this Declaration in further support of Applicant's response to the Dismissal of its Petition of August 6, 2008.

2. I am a partner with the law firm of Dickstein Shapiro LLP. I was the attorney who handled the above-captioned application, as well as the parent application (07/426,917) and the child application (08/202,985). All references I make to myself in the paragraphs below are to be viewed in my capacity as a patent attorney with the law firm of Dickstein Shapiro LLP (formerly known as Dickstein Shapiro & Morin LLP).

3. I filed Application Serial No. 07/426,917 ('917) on October 26, 1989. The '917 patent application eventually issued on August 31, 1993 as U.S. Patent 5,241,671.

4. Encyclopaedia Britannica, Inc. desired to file a continuation application during the pendency of the '917 patent application.

5. A continuation patent application was filed under 37 CFR §1.60 on the date of issuance of the '671 patent application. That continuation application, which was eventually assigned Serial No. 08/113,893 ('893) was filed with the requisite filing fee, a declaration and a preliminary amendment with a claim for priority under 35 USC §120.

6. Since I did not receive confirmation of filing the '893 patent application from the courier, I filed a second patent application using a copy of the first filed continuation application. The second application was filed under 37 CFR §1.53. The second application was filed without a filing fee, a declaration or a claim for priority. The second application was eventually assigned Serial No. 08/113,955 ('955).

7. At the time of filing the '955 application, I intended that application to be a back-up in the event that the '893 application was not timely received by the PTO.

8. At the time of filing the '955 application, I believed the application copy was a complete copy of the '917 application. Although I do not remember the details associated with

that filing, it was and is my practice to check the number of pages in patent applications being filed. It seems possible that since the pages were numbered sequentially, and only the title page did not have a page number, I could have assumed page one was the title page. It is also possible that I only checked the transmittal page of that application to see if the number matched the numbering of the last page of the as-filed specification which had a total page count equivalent to what I believed to be a correct total number of pages. In any event, after many years, I do not have a recollection of the actual events associated with that filing.

9. On September 14, 1993, the PTO mailed a Notice of Incomplete Application in the '955 application indicating that page 1 was missing. Applicant was given the option of submitting the missing page and obtaining as a filing date for the application, the date of receipt of that missing page or keeping the application without page 1 and retaining the original filing date. Encyclopaedia Britannica opted for the latter option.

10. On October 1, 1993, the PTO mailed a Notice of Incomplete Application due to a missing page 1 for the '893 application with exactly the same options provided in the '955 application.

11. As I discovered much later, while investigating the files for the purpose of preparing this Declaration, our Firm's administrative staff placed both of the application copies, i.e., the '893 and the '955 application copies in the same file-wrapper, presumably because it was our intention to file a single continuation application.

12. On October 29, 2003, I filed a preliminary amendment in the '955 application deleting the incomplete text on page 2 and I also filed a Petition for the original filing date. On the same date, an express abandonment was filed in the '893 application. While I can no longer recall why I filed a petition in the '955 application and why an express abandonment was filed in the '893 application, it is my belief that I may have been confused by the presence of documents filed for both applications in the same file-wrapper. Nevertheless, given my certainty that one of the applications was going to be perfected by way of a petition, it made no sense to maintain a 2nd identical application in a pending status.

13. On February 16, 1994, the PTO dismissed the Petition in the '955 application for lack of a proper Declaration and provided a two month period for reconsideration under 37 CFR §1.181(f).

14. I had some difficulty in obtaining all the inventors' signatures on the Declaration. Part of the difficulty was due to the need to obtain the signature of the administrator of the estate of David Maatman, one of the co-inventors of the '893 and '955 applications who had died intestate. The signature was not available during an intestacy proceeding in state court.

15. On February 28, 1994, I filed a Request for an extension of time in the '955 application and also filed application 08/202,985 ('985) as a continuation application under 37 CFR 1.53 claiming priority to the '955 application.

16. Given my belief that priority in the '985 application was correctly claimed, I filed an amendment on September 11, 1995, requesting continuation data be placed on the first page of the '985 application (now page 2). That statement indicated that the 08/113,955 application was a continuation of the 07/426,917 patent application. The '985 patent application was also filed without page 1.

17. The Petition regarding missing page 1 and the petition to accept the Declaration with less than all the inventors' signatures was ultimately granted in the '985 application.


18. The PTO granted priority requested under 35 USC §120 to the '917 application, and I believed that the '985 application properly claimed priority benefits under 35 USC §120 to the parent ('955) and grandparent ('917) applications.

19. Prosecution of the '985 application occurred without my being alerted to any problems relating to the priority claim. I was not made aware that there were any issues concerning priority of the '955 application until on or about October 5, 2007 as indicated by the attached letter (Exhibit 1).

I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge, information and belief.

Dated: October 6, 2008

Respectfully submitted,

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